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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,316	04/02/2001	Mark D. Austin	BS01-058	7343
36192	7590	07/28/2005	EXAMINER	
CANTOR COLBURN LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			CUMMING, WILLIAM D	
		ART UNIT	PAPER NUMBER	
			2683	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/822,316	AUSTIN & JABARRY
	Examiner WILLIAM D. CUMMING	Art Unit 2683

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 10, 11 and 33 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8, 10, 11 and 33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

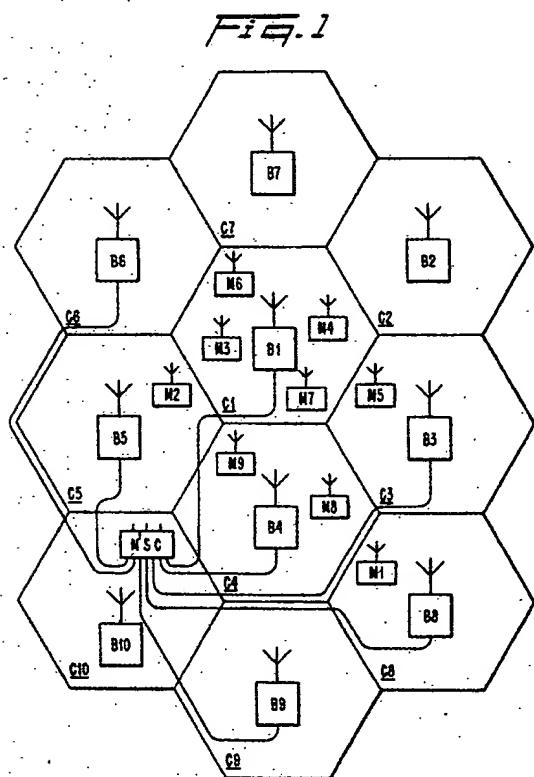
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Bodin, et al.**

Bodin, et al disclose a method effecting a handoff in a cellular network (figure 1) comprising the steps of monitoring a set of frequencies listed in a mobile assisted handoff ("In FIG. 3A, the entering signal strength threshold of cell C4 in the direction of cell C4 is represented by the value "a" which is depicted by an arrow representing the difference between SS4-SS1. FIG. 3 illustrates an example of a method for dynamically varying the handoff thresholds in accordance with the present invention. In FIG. 3A, when a mobile station, which is pictorially represented as an automobile, moves from base station B1 to B4, a handoff is considered once the measured signal strength drops below the staying or SSH threshold, and the handoff is granted when SS4-SS1.gtoreq.a. In other words, the handoff from cell C1 to cell C4 is delayed until the signal strength measured at base station B4 is greater than the signal strength measured at base station B1, as indicated by the value "a". The measurements may

alternatively be performed downlink in the mobile if mobile-assisted handoff is available.")



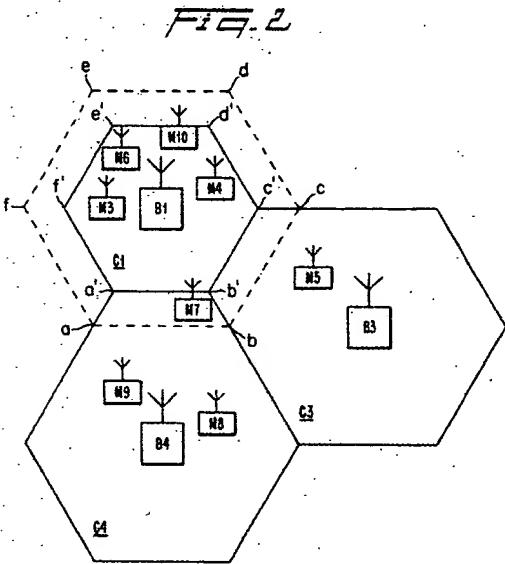
Logically ordering the frequencies based on their relative signal strengths ("Each cell is always equipped with a signal strength receiver which consists of a receiver and a control unit. The signal strength receiver is typically the same design as the receiver used for each voice channel. The signal strength receiver in each cell performs cyclical measurements, sampling the radio frequencies received from the mobile stations. All the system frequencies may be sampled but only the

voice channel frequencies allocated to mobile stations in the neighboring cells are of interest for handoff. The information about which channel should be taken under consideration, during the above-mentioned sampling is originally received from the MSC. The measurement results are updated, in the control unit as a mean value after each cyclic sampling. In this way each cell knows what the signal strength with any mobile station currently using a neighbor's voice channel would be if the cell in question would have to take over the transmission. If a handoff has been requested by a cell, the MSC will ask the neighboring cell to send the measurement results of the signal

strength from the mobile station." And "The signal strength results are always available in each cell. On request they will be provided to the MSC which looks for the best result. When the measured signal strength satisfies the dynamically variable entering threshold, the MSC can then determine the target cell for handoff. When the cell is determined, the MSC looks for an idle voice channel in the cell. If all the voice channels are busy at the moment, the next best cell is taken providing that it also fulfills the criteria. When the voice channel has been selected an order to start the transmitter in the base station is issued to the new cell. Then an order to the mobile station for turning to the selected voice channel is sent. The base station in the new cell and the mobile

station can then communicate with one

another.")

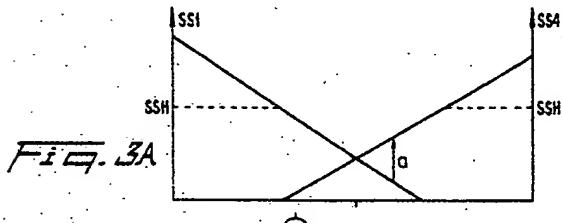


Identify in the logically ordered set of frequency those frequencies having a signal strength higher ("According to the present invention as illustrated in FIG. 2, a voice channel in cell C1 may be vacated and access can be given to the mobile station M10 by reducing the size of cell C1. By dynamically varying the entering thresholds of

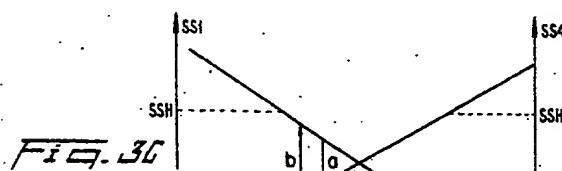
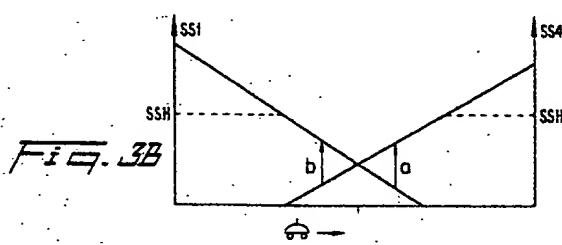
cells C1 and C4, the sizes of cells C1 and C4 are decreased and increased respectively. The SSH threshold (the staying threshold) is an absolute value. It is only used to limit the amount of handoff processing. It is of no importance functionally since it

is always above the absolute values associated with the entering thresholds. The mobile station M7 formerly at the periphery of cell C1 now lies within the expanded area of cell C4 and can be handed off by the normal handoff routine. Typically in the prior art, the entering thresholds between cell C1 and its six neighboring cells C2-C7 are the same and a handoff usually occurs when the signal strength satisfies the entering threshold. In the present invention, however, the entering thresholds between cell C1 and each cell C2-C7 may be different and the mobile station is not handed off until the entering threshold is exceeded as hereinafter explained. Moreover, in the prior art the entering threshold for a mobile station entering cell C1 from cell C2 (in FIG. 1) would typically be the same as the entering threshold of a mobile station entering from cell C4. In the present invention, however, there is an entering threshold for mobile stations entering cell C1 from cell C2, and this entering threshold may be different from the

entering threshold for mobile stations entering
cell C1 from cell C4."



Associating a cellular site with at least each frequency in the set of frequencies ("The signal strength results are always available in each cell. On request they will be provided to the MSC which looks for the best result. When the measured signal strength satisfies the dynamically variable entering threshold, the



MSC can then determine the target cell for handoff. When the cell is determined, the MSC looks for an idle voice channel in the cell. If all the voice channels are busy at the moment, the next best cell is taken providing that it also fulfills the criteria. When the voice channel has been selected an order to start the transmitter in the base station is issued to the new cell. Then an order to the mobile station for turning to the selected voice channel is sent. The base station in the new cell and the mobile station can then communicate with one another."

Determining a level of traffic at each cellular site ("According to the present invention, it is possible to decrease the enter threshold of all neighbors C2 . . . C7 relative to cell C1 and to increase the enter thresholds of cell C1 relative to all its neighbors, thus maintaining the base station of cell C1 in the middle of this cell. However, according to the invention, it is alternatively possible to consider the traffic occupation level of the cells C2 . . . C7. If, e.g., the cell C4 has a comparatively low traffic occupation level, the enter threshold is lowered only for this cell C4 relative to cell C1 and the enter threshold rises only for cell C1 relative to cell C4. In this case the base station B4 of cell C4 will not be in the center of its cell anymore. It is even conceivable that a cell is reduced in size on one side and increased in size on the opposite side, thus displacing the cell towards a region of higher traffic, in order to help carry that traffic.").

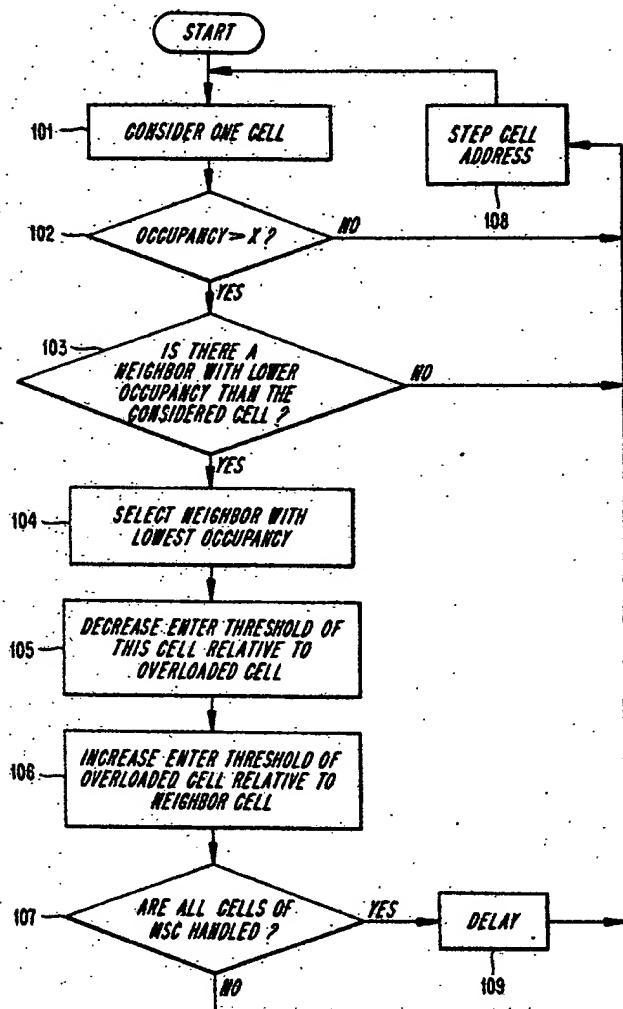


FIG. 4

Selecting a cellular site for handoff based at least in part on signal and in part the level of traffic ("One advantage of this method is the fact that no handoff order needs to be given to any mobiles as a result of heavy traffic in certain cells, but the conditions for handoff are changed such that normal handoff activity will redistribute traffic more evenly.").

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bodin, et al** in view of well known subject matter as evidence by **Balachandran**.

Bodin, et al disclose all subject matter, except for ordering the frequencies from highest to lowest signal strength. The examiner takes Official Notice that ordering the frequencies from highest to lowest signal strength is an decade old and well known in the art in methods of effecting handoff. The examiner cites **Balachandran** as evidence as such. Clearly applicants did not invent this. Hence, it would have been obvious to one of ordinary skill in the art

at the time the claimed invention was made to incorporate the old and well known use of ordering the frequencies from highest to lowest signal strength in the method of effecting a handoff in a cellular network in order to pick the frequencies or channels with the strongest signal.

Response to Amendment

7. New Patents Central FAX Number And Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence

The United States Patent and Trademark Office (Office) requires most patent related correspondence to be: **a**) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), **b**) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), **c**) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or **d**) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence.

New Central FAX Number: On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

General "Centralized Delivery" Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window, and facsimile transmissions must be sent to the Central FAX number (571-273-8300), unless an exception, as noted below, applies. Exceptions to the general policy of "centralized delivery" generally involve situations where special handling of the patent related correspondence is available. All the current exceptions are listed in this notice. Correspondence which is not related to a specific patent or patent application, such as a question on policy, on employment, or other general inquiry, is not covered by this notice.

Updated Lists of Exceptions: Lists I and II below set forth all the current exceptions to the "centralized delivery" policy and reflect certain changes since exceptions were last published on March 29, 2005.ⁱ One change is that all facsimile-transmitted correspondence specifically directed to the Office of Initial Patent Examination must now be sent to the Central FAX number as the prior exceptions relating to facsimile-

transmitted requests for corrected filing receipts and responses to Notices to File Missing Parts have been eliminated. Exceptions were added at the end of Lists I and II for correspondence for the Office of Enrollment and Discipline and correspondence for the Office of Finance. List I, exception 8 was updated to reflect that a drop box is now located at the guard station in the Knox building for hand-carried petitions for a foreign filing license pursuant to 37 CFR 5.12(b) for which expedited handling is requested, and hand-carried petitions for a retroactive license under 37 CFR 5.25. List II, exception 6 was updated to reflect that the facsimile number exception for correspondence related to reexamination proceedings other than the initial request now applies to *ex parte* reexamination as well as *inter partes* reexamination proceedings.

List I – Exceptions for Certain Hand Carried Correspondence

Current exceptions: Only the following types of correspondence may be delivered (hand-carried) to the specific location provided below instead of the Customer Service Window. If correspondence listed below is carried to the Customer Service Window, the correspondence will be accepted and routed to the appropriate office.

1. Access Requests: Requests for access to patent application files may continue to be hand carried to the File Information Unit (FIU) in Room 2E04, 2900 Crystal Drive (South Tower), Arlington VA 22202. Requests for access to patent application files that are maintained in the Image File Wrapper system and that have not yet been published may also be hand carried to the Public Search Facility on the 1st floor of the Madison East building, 600 Dulany Street, Alexandria VA 22314.

2. Patent Term Extensions under 35 U.S.C. § 156: Patent term extension applications under 35 U.S.C. 156 (Hatch/Waxman) may be hand-carried to the Office of Patent Legal Administration (OPLA) in Room 7D85, 600 Dulany Street (Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the OPLA at either 571-272-7744 or 571-272-7746 for delivery assistance.

3. Assignments to be Recorded: Assignments may be hand-carried to the Office of Public Records Customer Service Window on the 2nd floor of the South Tower building, 2900 Crystal Drive, Arlington VA 22202.

4. Office of General Counsel: Correspondence for the Office of General Counsel may be hand-carried to the Office of General Counsel in Room 10C20, 600 Dulany Street (Madison East building), Alexandria VA 22314. At the guard station in Madison East (near the elevators), the security guard should call the Office of General Counsel at 571-272-7000 for delivery assistance.

5. Solicitor's Office: Correspondence for the Solicitor's Office may be hand-carried to the Solicitor's Office in Room 8C43, 600 Dulany Street (Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Solicitor's Office at 571-272-9035 for delivery assistance.

6. Interference related correspondence: Correspondence relating to interferences may be hand-carried to the 1st floor lobby of Madison East building,

600 Dulany Street, Alexandria VA 22314, where a drop-off box for hand-carried documents to be filed with the Board of Patent Appeals and Interferences is located. Customers need to pass through the magnetometer and have the materials passed through the x-ray sensors before placing them in the drop-off box. The drop-off box is for Interference related correspondence ONLY. Boxes are not permitted in the drop-off box. Boxed materials should be hand-carried to Madison East, Room 9B55-A using the following procedures. At the first floor guard station in Madison East (near the elevators), the security guard should call the Board of Patent Appeals and Interferences at 571-272-9797 to obtain authorization to allow entry into the building for delivery to Room 9B55-A. Access to Room 9B55-A is available on business days from 8:30 a.m to 4:45 p.m. only. Documents/boxes hand-carried to the drop-off box or to Room 9B55-A after 4:45 p.m. (EST) will receive the next business day's filing date. Customers desiring a stamped return receipt for their filing need to personally bring their filing and postcard to Room 9B55-A during the hours stated above, or leave the postcard with the filing (postcard must include correct postage mail stamp and the address where the postcard is to be mailed). The Board will stamp the filing date and mail the postcard to the customer.

7. Secrecy Order: Applications subject to a secrecy order pursuant to 35 U.S.C. 181, or which are national security classified, and correspondence related thereto, may be hand-carried to the Licensing and Review location. See 37 CFR §§ 5.1(c) and 5.2(c). The Licensing and Review location is: Technology Center 3600, Room 4B31, 501 Dulany Street (Knox building), Alexandria VA 22314. At the guard station in Knox (near the elevators), the security guard should call Licensing and Review at 571-272-8203 for delivery assistance.

8. Expedited Foreign Filing License Petitions: Petitions for a foreign filing license pursuant to 37 CFR 5.12(b) for which expedited handling is requested and petitions for a retroactive license under 37 CFR 5.25, may be hand-carried to the drop box located at the guard station in the Knox building. Upon approaching the guard station, the delivery personnel should state their desire to drop off the request. Correspondence packages will be inspected/scanned before being placed in the drop box. All requests should identify a fax number, telephone number and mailing address. All responses to the request will be sent by fax, followed by a mailed copy. If a fax number is not available, a hardcopy will be mailed to the mailing address provided.

9. Petitions to Withdraw from Issue: Petitions to Withdraw from Issue may be hand carried to the Office of Petitions on the 7th floor of the Madison West building, 600 Dulany Street, Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Office of Petitions at 571-272-3282 for delivery assistance. Hand carried papers will be accepted on business days between the hours of 8:30 a.m. until 3:45 p.m.

10. Documents requested by the Office of Patent Publication: Documents requested by the Office of Patent Publication may be hand carried to the Office of

Patent Publication in Room 8A24, 2900 Crystal Drive (South Tower building), Arlington VA 22202, during business hours.

11. Office of Enrollment and Discipline (OED): Correspondence for the Office of Enrollment and Discipline may be hand-carried to the receptionist at Room 8C43-B, 600 Dulany Street (Madison East building), Alexandria VA 22314. At the guard station in Madison East (near the elevators), the security guard should call the Office of Enrollment and Discipline at 571-272-4097 for delivery assistance.

12. Office of Finance: Refund requests, deposit account replenishments, and maintenance fee payments may be hand-carried to the Office of Finance receptionist in Suite 300, 2051 Jamieson Avenue (Carlyle Place building), Alexandria, VA 22314. Hand-carried correspondence will only be accepted, and not processed. Although the receptionist will not process any correspondence, if the correspondence is delivered with an itemized postcard, the receptionist will provide a delivery receipt by date stamping the postcard. Depending on whether the correspondence is a refund request, deposit account related (e.g., a deposit account replenishment), or maintenance fee related (e.g., a maintenance fee payment), the correspondence should be placed in an envelope with REFUND, DEPOSIT ACCOUNT, or MAINTENANCE FEE written in dark ink across the envelope.

List II - Exceptions for Certain Facsimile Transmitted Correspondence

For each Office location listed below, only the particular type of correspondence indicated may be transmitted to the specific facsimile number at that Office location. All other types of facsimile transmitted correspondence must be sent to the Central FAX number (571-273-8300).

1. PCT Operations and PCT Legal Administration: Correspondence subsequent to filing in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority:

Papers in international applications: 703-305-3230 facsimile number
Response to Decisions on Petition: 571-273-0459 facsimile number.

Note: An international application for patent or a copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b), may NOT be submitted by facsimile. See 37 CFR 1.6(d)(3) (referencing 37 CFR 1.8(a)(2)(i)(D) and (F)). Subsequent correspondence may be transmitted by facsimile in an application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority, but it will NOT receive the benefit of any certificate of transmission (or mailing). See 37 CFR 1.8(a)(2) (i)(E). Correspondence during national stage, subsequent to entry, are handled in the same manner as a U.S. national application.

The PCT Help Desk: 571-273-0419 facsimile number 571-272-4300
telephone number

2. Office of Patent Publication: Payment of an issue fee and any required publication fee by authorization to charge a deposit account or credit card, and drawings: 703-746-4000 facsimile number

Note: Although submission of drawings by facsimile may reduce the quality of the drawings, the Office will generally print the drawings as received.

Office of Patent Publication telephone numbers to check on receipt of payment: 703-308-6789 or 1-888-786-0101

3. Office of Pre-Grant Publication

Petitions for express abandonment to avoid publication under 37 CFR 1.138(c), and Requests for express abandonment under 37 CFR 1.138: 703-305-8568 facsimile number

Pre-Grant Publication Division telephone number for questions relating to the publication of patent applications: 703-605-4283. Questions may also be directed by e-mail to pgpub@uspto.gov.

4. Electronic Business Center (EBC)

Requests for Customer Number Data Change (PTO/SB/124), and Requests for a Customer Number (PTO/SB/125): 571-273-0177 facsimile number

Note: The EBC may also be reached by e-mail at: ebc@uspto.gov.
EBC telephone number for customer service and assistance: 866-217-9197

5. Assignment Branch

Assignments or other documents affecting title: 703-306-5995 facsimile number

Note: Customers may submit documents directly into the automated Patent and Trademark Assignment System and receive the resulting recordation notice at their facsimile machine. (Assignment documents submitted through the Electronic Patent Assignment System also permits the recordation notice to be faxed to customers.) Credit card payments to record assignment documents are now accepted, and use of the Credit Card form (PTO-2038) is required for the credit card information to be separated from the assignment records. Only documents with an identified patent application or patent number, a single cover sheet to record a single type of transaction, and the fee paid by an authorization to charge a USPTO deposit account or credit card may be submitted via facsimile. Please refer to the USPTO Web Site, at <http://www.uspto.gov/web/offices/ac/ido/opr/ptasfax.pdf> for more information regarding the submission of assignment documents via facsimile.

Assignment Branch telephone number for assistance: 703-308-9723

6. Central Reexamination Unit (CRU)

Ex parte and *Inter partes* reexamination correspondence, except for the initial request: 571-273-0100 facsimile number

Note: Correspondence related to reexamination proceedings will be separately scanned in the CRU.

CRU telephone number for customer service and inquiries: 571-272-7705

7. Board of Patent Appeals and Interferences

Correspondence related to pending interferences permitted to be transmitted by facsimile (only where expressly authorized, see 37 CFR 1.6(d)(9)): 571-273-0042 facsimile number

Note: Correspondence should not be transmitted to this number if an interference has not yet been declared.

8. Office of the General Counsel

Correspondence permitted to be transmitted to the Office of General Counsel: 571-273-0099 facsimile number

9. Office of the Solicitor

Correspondence permitted to be transmitted by facsimile to the Office of the Solicitor: 571-273-0373 facsimile number

10. Licensing and Review

Petitions for a foreign filing license pursuant to 37 CFR 5.12(b), including a petition for a foreign filing license where there is no corresponding U.S. application (37 CFR 5.13):

571-273-0185 facsimile number

Note: Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR Sec. 5.1 through 5.5 and directly related to the secrecy order content of the application may NOT be transmitted via facsimile. See 37 CFR Sec. 1.6(d)(6).

11. Office of Petitions

Petitions to Withdraw from Issue: 571-273-0025 facsimile number

Note: All other types of petitions must be directed to the Central FAX Number (571-273-8300). Petitions to Withdraw from Issue sent to the Central FAX Number should be marked "Special Processing Submission".

12. Office of the Enrollment and Discipline

Correspondence permitted to be transmitted to the Office of Enrollment and Discipline: 571-273-0074 facsimile number

13. Office of Finance

Refund requests, deposit account inquiries, and maintenance fee payments: 571-273-6500 facsimile number

Office of Finance telephone number for customer service and inquiries: 571-272-6500

Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center by telephone at 800-786-9199, or 571-272-1000.

6/20/05 /s/

Response to Arguments

8. Applicant's arguments filed April 2, 2001 have been fully considered but they are not persuasive.

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "inherent" or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11).

In response to Applicant's argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. It was held in In re Donohue, 226 USPQ 619, that, "*It is well settled that prior art under 35 USC §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it... Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention.*" Clear inference to the artisan

must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome “heavy presumption” that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). “*Arguments that the alleged anticipatory prior art is nonanalogous art’ or teaches away from the invention’ or is not recognized as solving the problem solved by the claimed invention, [are] not germane’ to a rejection under section 102.*” Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference “teaches away” from the invention is inapplicable to an anticipation analysis. Celeritas

Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

The plain meaning of logical is of, relating to, in accordance with, or of the nature of logic; based on earlier or otherwise known statements, events, or conditions; and reasonable and reasoning or capable of reasoning in a clear and consistent manner. (*The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company.*). Clearly, **Bodein, et al** logically orders his signals/frequencies/channels on ones that meet or surpass the threshold (based on earlier or otherwise known statements, events, or conditions) and the ones, which do not. (*Each cell is always equipped with a signal strength receiver which consists of a receiver and a control unit. The signal strength receiver is typically the same design as the receiver used for each voice channel. The signal strength receiver in each cell performs cyclical measurements, sampling the radio frequencies received from the mobile stations. All the system frequencies may be sampled but only the voice channel frequencies allocated to mobile stations in the neighboring cells are of interest for handoff. The information about which channel should be taken under consideration, during the above-mentioned sampling is originally received from the MSC. The measurement results are updated, in the control unit as a mean value after each cyclic sampling. In this way each cell knows what the signal strength with any mobile station currently using a neighbor's voice channel would be if the cell in*

question would have to take over the transmission. If a handoff has been requested by a cell, the MSC will ask the neighboring cell to send the measurement results of the signal strength from the mobile station.

"During a call in progress, voice channel equipment in each of the base stations B1-B10 continuously supervises the radio transmission parameters. Each voice channel unit performs continuous measurements of the received signal strength on its own radio frequency. The control unit evaluates these measurement results against threshold values which are command initiated parameters that are stored in the control units of each voice channel. A signal strength threshold value for handoff requests, SSH, is set by command for each cell. When the value of a signal coming from a mobile station falls below the SSH threshold value which indicates poor transmission quality, the mobile station is considered for handoff to a neighboring cell.")

If applicants claim their invention so broadly, it should not come to surprise to applicants that the examiner also examines the claims just as broadly.

The application is NOT condition of allowance and the notification to this effect is DENIED.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. **A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**

11. New Pre-Appeal Brief Conference Pilot Program

This new program offers applicants an avenue to request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief. Effective immediately, the USPTO is offering applicants an optional procedure to review the examiner's rejection prior to the actual filing of an appeal brief. The program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal. Although this procedure will not be appropriate in every appealed application, in the proper situations it can save both the resources of the applicant and the Office. Applicants continue to have available to them the normal practice and procedures already in effect under Part 41 of the Title 37 of the Code of Federal Regulations relating to appeals and practice before the Board of Patent Appeals and Interferences.

[A] General Provisions:

What is this program?

Under the current practice every applicant whose claims have been twice rejected may appeal the examiner's decision to the Board of Patent Appeals and Interferences. To do so, the applicant first files a notice of appeal accompanied by the appropriate fee i within the appropriate time period ii. Within two months from the date of the filing of the notice of appeal, applicant must file an appeal brief accompanied by the appropriate fee iii. Applicants may buy extensions of time for filing the appeal brief.

This pilot program offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference currently employed in the Office, but prior to the filing of an appeal brief. The goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a *prima facie* rejection.

Who can use this program?

Any applicant who has filed a notice of appeal and who wants a panel of experienced examiners to perform a detailed review of appealable issues within a set period of time.

How to decide if you should request this panel review?

If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief. This should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings. The latter is more appropriate for the traditional appeal process currently employed by applicants.

What happens during a panel review?

A panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

When should you file an appeal brief or other correspondence?

This program is designed to allow applicants who think there is a clear deficiency in the *prima facie* case in support of a rejection to file the request at the same time that they file a notice of appeal. This affords the Office the best opportunity to ensure that applicant will promptly receive a decision on the request. If the request is filed with the notice of appeal, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.

What actions will terminate the panel's review?

If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- an appeal brief
- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment

A request for the declaration of an interference will also result in an end to the review process. Applicant will be promptly notified by an Office communication of termination or of dismissal of the request. If any of the above-noted actions occur, the period for filing the appeal brief (if applicable) will be the later of the two-month period set in 37 CFR

41.37(a) or one month from the mail date of the decision on the request.

[B] Conditions Necessary to Request a Panel Review:

- Applicant must file a notice of appeal in compliance with 37 CFR 41.31.
- Applicant must file the request with the filing of a notice of appeal and before the filing of an appeal brief. 1

[C] Content of Request:

a. File the request and accompanying arguments in a separate paper entitled, "Pre-Appeal Brief Request for Review". A sample request form has been created and is available on the USPTO Internet Website, on the forms page, as PTO/SB/33.

b. In five (5) or less total pages, provide a succinct, concise and focused set of arguments for which the review is being requested.

c. File the request with the notice of appeal.

d. Address the notice of appeal and the request to

- Mail Stop AF
- Commissioner for Patents
- P.O. Box 1450
- Alexandria, VA 22313-1450

- Fax the notice of appeal and the request to the Central FAX Number (now 571 273-8300)

- Hand carry the notice of appeal and the request to the

USPTO Customer Service Window, ATTN: Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

e. No after-final or proposed amendments may accompany the request. iv

A request that fails to comply with the above noted submission requirements may be dismissed.

[D] Content of Remarks or Arguments:

The request should specify-

- . clear errors in the examiner's rejections; or
- . the examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103).

Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at pages 4 to 6). However, references such as "see the arguments of record" or "see paper number X" are not helpful and will just obfuscate the real issues for review.

The request may not be more than five (5) pages total and the remarks should be drafted with the expectation that for a clear error in fact or other deficiency, a long detailed explanation is not needed. Requests are limited to appealable, not petitionable matters.

Any actual issues lacking factual basis, including interpretations of the prior art teachings or claim scope as contrasted with clear error in facts, are appropriate for the traditional appeal process and submission of the appeal brief. For grounds where a clear issue on proper interpretation exists, applicant is advised to proceed to appeal with the timely filing of the appeal brief. This program is not intended to be, and is not, an alternative for filing an appeal.

[E] USPTO Consideration of the Request:

Upon receipt of a properly filed request, a Technology Center Art Unit supervisor will designate a panel of examiners experienced in the field of technology to review the applicant's remarks and the examiner's rejections. The panel will include at least a supervisor and the examiner of record. The applicant will not be permitted to attend the review and no interviews will be granted prior to issuance of the panel's decision.

The panel members will review the rejection(s) identified by applicant in the request. They will also review the application and the appropriate evidence in support of the rejections to the extent necessary. The panel will then decide if an issue for appeal is, in fact, present in the record. The Office should mail a decision within 45 days of receipt of a properly

filed request.

[F] Format of Panel Decision:

After the review is complete, the Office will mail a decision on the status of the application. The decision will state one of the following:

- . Finding 1: The application remains under appeal because there is at least one actual issue for appeal.
- . Finding 2: Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).
- . Finding 3: The application is allowed on the existing claims and prosecution remains closed.
- . Finding 4: The request fails to comply with the submission requirements and is dismissed.

The decision will summarize the status of the pending claims (still rejected, withdrawn rejections, objected to or allowable claims).

A decision by a pre-appeal brief conference panel to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences, and, as such, would not result in any patent term extension or adjustment under 35 U.S.C. Sec. 154(b) (37 CFR 1.701(a)(3) and 1.702(e)).

The decision will not contain any additional grounds of rejection or any restatement of previously made rejections. Such matters will be addressed, as appropriate, in the Examiner's Answer.

[G] Time Periods Before/After a Panel Decision:

- . The request must be filed with the filing of a notice of appeal and before the filing of the appeal brief. No extensions of time are available for filing the request for review.
- . The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable. To the extent that any existing USPTO rule

is inconsistent with this pilot program, the rule is waived until regulations directed to pre-appeal brief conferences are promulgated, or the pilot program is ended. For example, if a request for a pre-appeal brief conference is filed with a notice of appeal, the time period set in 37 CFR 41.37(a)(1) is waived so that an appeal will not stand dismissed if an appeal brief is not filed within two months of the filing date of a notice of appeal, but is filed within one month of the decision on the request.

Applicant's period for filing the appeal brief or other appropriate response ends on the mailing date of a panel decision that indicates all claims are allowed or that prosecution is reopened.

[H] Administrative Matters:

- Applicants should ensure that requests are mailed or faxed with the notice of appeal to ensure timely filing. The request should contain a certificate of mailing or transmission under 37 CFR 1.8 and be listed on any postcard receipt (MPEP 503).
- No supplemental requests or arguments will be accepted.
- The notice of appeal fee is not refundable, even in the event of a decision favorable to applicant.
- A request filed after the date of receipt of the notice of appeal will be dismissed as untimely.
- This procedure does not affect petitions to invoke supervisory authority under 37 CFR 1.181 because such petitions address procedural matters, not appealable, matters.
- Panel decisions will not be petitionable because a decision to maintain a rejection is subject to appeal.
- A pre-appeal brief conference panel decision that the application remains under appeal is not final agency action for purposes of court review. An applicant dissatisfied with the result of the appeal conference must pursue the appeal before the Board of Patent Appeals and Interferences.
- This process does not apply to reexamination proceedings.
- Following a panel review under this pilot program, the examiner retains the option to reopen prosecution or to allow an application after the filing of an appeal brief. This unlikely situation might arise, for example, where new arguments or evidence are presented in the appeal brief.
- This pilot program will run for at least six months from its effective date. The Office may extend, terminate, revise or otherwise take appropriate action after evaluating its effectiveness at the end of that period. If the program is to be made permanent, the Office will

promulgate the appropriate changes to title 37 of the Code of Federal Regulations.

Please direct inquiries with respect to a pending request for a pre-appeal brief conference to the examiner to whom the patent application is assigned, or the examiner's immediate supervisor. Please direct comments and inquiries on this pilot program to Anton Fetting via email addressed to anton.fetting@uspto.gov. You may also contact Mr. Fetting at (571) 272-7701.

June 20, 2005

12. If applicants wish to request for an interview, an "*Applicant Initiated Interview Request*" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed "*Applicant Initiated Interview Request*" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

13. If applicants request an interview after this final rejection, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D. CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Wednesday, 11:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM D. CUMMING
Primary Examiner
Art Unit 2683

Wdc



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